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EXAMINER	
DAGNEW, SABA	
ART UNIT	**PAPER NUMBER**
3688	
MAIL DATE	**DELIVERY MODE**
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/759,553	PERRY, MORGAN	
	Examiner	Art Unit	
	SABA DAGNEW	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,10-17 and 19-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,10-17 and 19-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *July 9, 2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15th July 2008 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "In advance" (e.g. in claim 1, lines 9 and 10).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8, 10-17 and 19-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court

precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. . Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 10-15 and 21-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Radwin (7,007,074 B2).

With respect to claims 1, Radwin teaches a method of distributing Internet advertisements to users, each associated with a unique identifier, the method comprising:

providing an advertisement ***(Col. 3, lines 14-17and Col. 5, lines 35-44);***

associating a web search term *with* the advertisement ***(Col. 3, lines 29-36),*** such that users employing the term ***(Col. 3, lines 19-29,*** *where "various search terms entered by the user" reads on users employing the term* ***and Col. 7, lines 28-30,*** *where "search term was last used to conduct a search" reads on users employing term)* in a search are desired recipients of the advertisement **(Col. 7, lines 4-12*)***

collecting search terms employed by a user ***(Fig. 3, 76 and Col. 6, lines 45-58)*** at a search facility (***Fig. 1 and Col. 4, lines 45-61,*** *teach search facility*) ; and

in response to the user visiting a publisher web site at a time subsequent to the association of the web search term with the advertisement ***(Fig. and Col. 11, lines 49-53),*** determining if the user has employed the search term in advance of the user visiting the publisher website ***(Col. 5, lines 14-28 and Col. 7, lines 4-9,*** *where desires information to prepared for a European vacation and user might enter search term "French Resorts"" reads on employing in advance of the user visiting the publisher web site* ***).***

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP § 2111.04). Accordingly, the following optional claim language in claims 1, 3, 6, 12, 13 and 20 was not given patentable weight:

"if the user has employed the search term, in advance of the user visiting the publisher website, then serving the search history/advertisement to the user "

Since the limitation of claim 3, "determining if the user has employed the search term including collecting the user's unique identifier in response to the user visiting the publisher web site, and querying the database for information about the search terms employed by user", executively depended on the optional limitation in claim 1, therefore, was not given patentable weight.

"if the user has employed any of the search terms associated with the advertising strategy over the period, assigning the user to the advertising strategy that includes serving to the user an advertisement associated with the advertising strategy"

"if the search terms do not relate to one of a collection selected advertisements"

With respect to claim 2, Radwin teaches all elements of claim 1. Furthermore, Radwin teaches storing in a database the search terms used by each user in association with the identifier of each user ***(Fig. 3, and Col. 6, lines 45-58)***

With respect to claim 4, Radwin teaches all elements to claim 1. Furthermore, Radwin teaches the method including providing a plurality of advertisements, each having different associated search term **(*Col. 4, lines 21-26,*** *where "documents associated with the terms searched" reads on plurality of advertisement associated with different search terms)*.

With the respect to claim 5, Radwin teaches all elements of claim 1. Furthermore, Radwin teaches the method including providing a plurality of different databases, each containing a plurality of unique identifier and each database associate with a different advertisement ***(Fig. 3, Col. 6, lines 45-58*** *where "records" reads on database)*.

With respect to claim 6, Radwin teaches a method of distributing internet advertisement to users comprising:

associating a number of advertisements with an advertising strategy ***(Col. 3, lines 19-34****, where "advertisements and user profiler configured to communicate" reads on advertisements with an advertising strategy* ***and Col. 4, lines 34-39)***.

associating a number of search terms with an advertising strategy (***Col. 4, lines 34-39 and Col. 6, lines 45-58)***.

associating a time duration with the advertising strategy ***(Col. 3, lines 38-48)*** ;

assigning cookies to users of a search interface ***(Fig. 8, 808 and Col. 13, lines 19-22)***

storing the collected search terms for each user in association with each user's cookie***(Col. 13, lines 19-33)*** ;

based on the collected search terms (***Fig. 6, 602****, where "receive search terms" reads on collected search terms*), assigning each user to a selected advertising strategy by comparing a set of search terms associated with an advertising strategy (***Fig. 6, 606 and 610***) to search terms collected for the user over the immediately preceding period equal to the time duration associated with the advertising strategy ***(Fig. 6, 619 and 620 Col. 11, lines 49-67 and Col. 12 lines 1-5)*** and,

in response to a user visiting a publisher web site, after the user is assigned to a selected advertising strategy, enacting the selected advertising strategy ***(Fig. 6, 620 and Col. 12, lines 17-25)***.

With respect to claim 7, Radwin teaches all elements of claim 6. Furthermore, Radwin teaches the method wherein collecting a unique identifier associated with each user ***(Fig. 3** where "user 0 …user n" reads a unique indenter **and Col. 15, lines 29-34).***

With respect to claim 8, Radwin teaches all elements of claim 6. Furthermore, Radwin teaches the method wherein a collecting search term includes collecting combinations of multiple search terms **(Col. 10, lines 5-15)***.*

With respect to claim 10, Radwin teaches all elements of claim 6. Furthermore, Radwin teaches the method wherein assigning each user to an advertising strategy occurs before the user visits the publisher web site ***(Col. 5, lines 28-32, where teaches a search query initiated to user before visiting web site).***

With respect to claim 11, Radwin teaches all elements of claim 6. Furthermore, Radwin teaches a method of providing a plurality of selected advertisement ***(Col. 4, lines15- 18)***, each associated with a selected advertising strategy ***(Col. 4, lines 21-23),*** and wherein at least one the advertising strategies comprised a default strategy in which none of the selected advertisements are served (***Col. 14, lines 2- 7**, where "run of the network advertisement" reads on default strategy).*

As noted above, claims 12 and 13 are written as options, which do no limit (MPEP § 2111.04), and where accordingly not given patentable weight.

Radwin does not explicitly teach in claims 14 serving no advertisement if the search terms do no relate to one of a collection of selected ads. However, that is inherent when there is no result to execute because the search terms do not produce a result/ad, which reads on serving no ad

Claim 15 is taught inherently because enacting/serving/executing cannot be at the same instant as searching.

With respect to claim 21, Radwin teaches all elements of clam 1, the method of claim 6 wherein collecting search terms comprises collecting a history of inquiries the user has submitted over a predetermined length of time (***Fig. 3 Col. 7, lines 28-30,*** *where "time stamp 77 identifies search term last used" reads submitted over predetermined length of time*).

With respect to claim 22, Radwin teaches all elements of claim 1. Furthermore, Radwin teaches collecting search terms comprises collecting a history of all queries the user has submitted to the search facility ***(Col. 4, lines 34-39, where*** *"storing search terms" reads on submitting to the search facility* ***and Col. 7 teaches, lines 21-40).***

With respect to claim 23, Radwin address by the rejection of claim 21 as cited above.

With respect to claim 24, Radwin addressed by the rejection of claim 22 as cited above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 16- 17 and 19-20 are rejected under 35 U.S.C. 103(a) as being obvious over Radwin (7,007,074 B2) in view of Ponte (6,826,559 B1)

With respect to claim 16, a method of distributing Internet advertisements to users comprising:

collecting search terms employed by users of a search facility***(Col. 11, lines 49-56*** *, where "search terms stored for later use" reads on collecting search terms* ***);***

collecting a unique identifier associated with each user ***(Fig. 3 and Col. 6, lines 45-58);***

storing the search terms and unique identifiers in a database, with each identifier associated with the search terms employed by the associated user ***(Col. 6, lines 1-10,*** *where database is inherent)* ***;***

in response to a user visiting a publisher web site, determining the user's unique identifier ***(Fig. 3,*** *where "user 0-n" reads on user identifier),* searching the database to determine an advertising strategy to which the user's unique identifier was assigned prior to the user's current visit to the publisher web site ***(Fig. 3 and Col. 6, lines 44-58),*** and serving to the user an advertisement strategy associated with the advertising strategy ***(Col. 12, lines, 17-35)***

Radwin teaches all the above elements, but Radwin does not teach generating a plurality of selected advertising strategies, each with an associated Boolean search expression, the Boolean search expression corresponding to search terms associated with the associated advertising strategy and assigning identifiers to at least one of the advertising strategies by comparing the search terms collected for the user to the Boolean search expression associated with each advertising strategy.

However, Ponte teaches generating a plurality of selected advertising strategies, each with an associated Boolean search expression ***(Col. 27, lines 19-22),*** the Boolean search expression corresponding to search terms associated with the associated advertising strategy (***Col. 27, lines 26-35***);

assigning identifiers to at least one of the advertising strategies (by comparing the search terms collected for the user to the Boolean search expression associated with each advertising strategy ***(Col. 27, lines 1-23).*** Therefore, it would have been obvious to the one ordinary skill in the art at the time invention was made to add Ponte's Boolean search expression feature to Radwin's time dependent advertising search method in order to provide user with efficient search system.

Radwin in view of Ponte teaches claim 16. Additionally, Radwin addressed claim 17 by the rejection of claim 8 as cited above.

Radwin in view of Ponte teaches claim 16. Additionally, Radwin addressed claim 19 by the rejection of clam 11 as cited above.

Radwin in view of Ponte teaches claim 16. Additionally Radwin addressed clam 20 by the rejection of claim 12 as cited above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SABA DAGNEW whose telephone number is (571)270-3271. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. D. /
Examiner, Art Unit 3688

/Donald L. Champagne/
Primary Examiner, Art Unit 3688